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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,146	04/14/2000	PETER FORD	RJENK9.001AP	5908
20995	7590	08/11/2005		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER LANIER, BENJAMIN E	
			ART UNIT 2132	PAPER NUMBER

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/463,146

Applicant(s)

FORD, PETER

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 and 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 11 February 2005 amends claims 19, 21, 22, 24, 28, 29, 32, 37 and cancels claim 26. Applicant's amendment has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments filed 11 February 2005 have been fully considered but they are not persuasive.
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
4. Applicant's arguments that the prior art does not disclose transmitting a transfer protocol identifier indicating that the encrypted broadcast message is of a type for data download to the removable module from the first mobile station and passing said encrypted broadcast message to the corresponding removable module in response to receipt of said transfer protocol identifier is not persuasive because Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status): Upon payment the mobile stations of the subscribers would be provided with the encryption keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). The SMS

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messages contain header information that discloses from which channel the mobile terminal can download the SMS message (Page 33). Diachina does not specify that the message decryption takes place in the smart cards. Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24), which meets the limitation of data download to the removable module from the first mobile station and passing said encrypted broadcast message to the corresponding removable module. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the smart cards of Diachina to decrypt message because Diachina discloses that the messages are decrypted using processing means of the mobile stations (Page 40, lines 18-20), and when the smart cards are inserted in the mobile stations they become processing means for the mobile station.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 19, 20, 24-36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina, WO 96/41493, in view of Chaney, U.S. Patent No. 5,852,290. Referring to claims 19, 20, 24, 25, 27-30, 32-34, 36, and 37, Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the encryption keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). Diachina does not specify that the message decryption takes place in the smart cards. Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the smart cards of Diachina to decrypt message because Diachina discloses that the messages are decrypted using processing means of the mobile stations (Page 40, lines 18-20), and when the smart cards are inserted in the mobile stations they become processing means for the mobile station.

Referring to claim 26, Diachina discloses that the SMS messages contain header information that discloses from which channel the mobile terminal can download the SMS message (Page 33).

Referring to claims 31 and 35, Diachina discloses that the channel can be GSM (Page 6, line 20).

8. Claims 21-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina, WO 96/41493, in view of Chaney, U.S. Patent No. 5,852,290 as applied to claim 19 above, and further in view of Farrugia. Referring to claims 21-23, Diachina discloses controlling digital control channels for broadcast SMS wherein SMS messages can be encrypted to support different classes of messaging service (access status). Based on appropriate fee payments, a subscriber would be able to decrypt SMS message of varying classes (preventing and allowing information access, first, second information access status). Upon payment the mobile stations of the subscribers would be provided with the keys for the SMS messages via over the air methods or manual entry of smart cards (removable module) into the mobile stations (Page 40, lines 5-27). Chaney discloses a smart card access control system for use in cellular communication wherein the smart cards of the cellular phones are used to decrypt messages (Col. 13, lines 17-24). Diachina does not disclose storing the keys on the smart cards in an encrypted form. Farrugia discloses the use of smart card technology with cellular networks where the key used to decrypt encrypted cellular message are stored in an encrypted fashion on the smart card of the subscribers mobile terminal (Page 101). It would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the keys of Diachina on the smart cards in order to control access to the keys as taught in Farrugia (Page 102).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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